

REMARKS

The entire claim set is presented to include claim 37 inadvertently missing from the Amendment filed February 8, 2006.

Claims 23-42 are pending, including independent claims 23, 27 and 36. Review and reconsideration on the merits are requested.

The present applications claims foreign priority from JP 2000-195621 filed June 29, 2000; JP 2000-213813 filed July 14, 2000; JP 2000-236044 filed August 3, 2000; and JP 2000-237897 filed August 7, 2006.

Claims 23-42 were rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,783,925 to Yasuda.

Due to a difference in inventorship identity, U.S. Patent No. 6,783,925 to Yasuda based on a U.S. Application filed July 14, 2000 is available as prior art under §102(e) against the claims of the present invention entitled to a U.S. filing date of June 29, 2001. Also, the laid-open *kokai* of JP 11-203413 and JP 11-273591 published as early as about January 16, 2001 are also available as prior art under §102(a) against the present claims.

The present application and Yasuda were subject to an obligation of Assignment to Fuji Photo Film Company, Ltd. at the time that the present invention was made.

1. Claims 23-26:

The subject matter of claims 23-26 is fully supported by JP 2000-213813 filed July 14, 2000, from which Applicants claim foreign priority under 35 U.S.C. § 119(a). Applicants submit

herewith the Verified English translation of JP '813 to thereby perfect their claim to priority and antedate Yasuda based on a U.S. Application filed on even date.

Withdrawal of the foregoing rejection with respect to claims 23-26 is respectfully requested.

2. Claims 27-42:

With respect to the laid-open *kokai* of Yasuda published as early as about January 16, 2001, the subject matter of claims 27-42 is fully described in JP '813 filed July 14, 2000, JP '044 filed August 3, 2000 and JP '897 filed August 7, 2000 upon which Applicants claim foreign priority under 35 U.S.C. § 119(a). Applicants submit herewith the Verified English translations of JP '813, JP '044 and JP '897 to thereby antedate the laid-open *kokai* of Yasuda.

On the other hand, as shown below, independent claims 27 and 36 are not anticipated by U.S. Patent No. 6,783,925 to Yasuda and therefore define novel subject matter.

With regard to independent claim 36, Yasuda merely carries out suction filtration prior to the dispersing operation. The passage at column 60, lines 5-15 cited by the Examiner does not disclose dispersing by a high pressure homogenizer or high speed rotary homomixer prior to suction filtration as required by claim 36. Thus, it is respectfully submitted that claims 36-42 are patentable over Yasuda, or at least are not anticipated by Yasuda.

On the other hand, claim 27 requires removing by-product salts contained in the reaction mixture by filtration through an ultrafiltration membrane during or after the reaction. Use of ultrafiltration enables an automated, continuous system and is superior to suction filtration. For example, ultrafiltration can be combined with a filtration module to form a liquid circulation

system. To the contrary, it is very difficult to automate a system using the suction filtration of Yasuda. This is because filtration residue must be removed after liquid supply, suction filtration and pouring of water are conducted several times. Systems employing suction filtration require much labor and exhibit low productivity. Thus, ultrafiltration is different from suction filtration, and Yasuda does not suggest that suction filtration in his working example can be replaced with ultrafiltration. Therefore, Yasuda also does not suggest the present invention. Thus, claims 27-35 are patentable over Yasuda, or at least are not anticipated by Yasuda.

As discussed above, the laid-open *kokai* of Yasuda have been antedated by perfecting the claim to foreign priority to JP '813, JP '044 and JP '897. Furthermore, as shown above, independent claims 27 and 36 differ from Yasuda each with respect to one or more elements thereof, and therefore are not anticipated by U.S. Patent No. 6,783,925 to Yasuda.

Should the Examiner find that claims 27 and 36 are not anticipated but remain obvious over Yasuda, the undersigned states that the present Application and U.S. Patent No. 6,783,925 to Yasuda, were, at the time that the invention was made, owned by, or subject to an obligation of Assignment to, the same person. Accordingly, U.S. Patent No. 6,783,925 to Yasuda which is available as prior art only §102(e)/103(a) has been disqualified for use in an obviousness rejection under 35 U.S.C. § 103(c).

Withdrawal of all rejections and allowance of claims 23-42 is earnestly solicited.

In the event that the Examiner believes that it may be helpful to advance the prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/815,957

Q80132

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Abraham J. Rosner
Registration No. 33,276

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: August 21, 2006